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| Notice of Allowability | Application No. | Applicant(s) | |
| | 10/032,254 | CHODOSH ET AL. | |
| | Examiner | Art Unit | |
| | Stephen L. Rawlings, Ph.D. | 1643 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12 May 2005.
2. ☒ The allowed claim(s) is/are 4,39,40,42,44, and 48.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| <ol style="list-style-type: none"> 1. <input type="checkbox"/> Notice of References Cited (PTO-892) 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____ 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | <ol style="list-style-type: none"> 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date <u>20051025</u>. 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance 9. <input type="checkbox"/> Other _____ |
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EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Evelyn H. McConathy on October 25, 2005.

2. The application has been amended as follows:

In the claims:

Claim 46 has been cancelled and claims 4, 39, 40, 42, 44, and 48 have been amended as follows:

4. (Currently Amended) An isolated nucleotide sequence comprising a the nucleotide sequence set forth in SEQID No:1.

39. (Currently Amended) An isolated recombinant cell comprising the isolated nucleotide sequence of claim 3 4.

40. (Currently Amended) A vector comprising the isolated nucleotide sequence of claim 3 4.

42. (Currently Amended) An isolated nucleic acid sequence comprising a the full complement ~~sequence complementary to all or part of the nucleic acid sequence of claim 3, and to mutants, derivatives, homologues or fragments thereof encoding a polypeptide having Pnck activity~~ 4.

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44. (Currently Amended) An isolated mammalian cell comprising the isolated ~~nucleic acid according to claim 42~~ full DNA complement of the nucleic acid sequence of claim 4.

46. (Canceled).

48. (Currently Amended) An isolated nucleotide sequence consisting of a the nucleotide sequence set forth in SEQID No: 1.

In the specification:

At page 38, lines 2 and 3, the following has been deleted:

“, (www.infomatic.jax.org”).

In the abstract:

The phrase “of the Invention” has been deleted from the title of the abstract.

Statement of Reasons of Allowance

3. The following is an examiner's statement of reasons for allowance:

According to the transmittal sheet accompanying submission of U.S. Provisional Application No. 60/257,073, the specification comprises the attached manuscripts and in particular, comprises Gardner et al. (*Genomics*. 2000 Jan 15; **63**: 279-288), which discloses the claimed nucleic acid sequence comprising the polynucleotide sequence SEQ ID NO: 1 and a vector comprising said nucleic acid sequence; and written support for recombinant, or more particularly mammalian cells comprising the disclosed nucleic acid sequence is found elsewhere in the attached manuscripts (e.g., page 112 of the 119 pages of attached manuscripts, which is numbered page 348). It is also noted that the attached manuscripts (i.e., publications), which are referred to at page 2, are incorporated in their entirety by reference at page 3. Accordingly, claims 4, 39, 40, 42,

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44, and 48 benefit from the earlier filing date of the provisional application, namely December 21, 2000.

As such, Gardner et al. is not prior art under 35 U.S.C. § 102(b) and the rejection of claims 4, 39, 40, and 42 under § 102(b) is moot. While Gardner et al. would be applied in a rejection of claims 4, 39, 40, and 42 under § 102(a), in responding to the preceding Office action, Applicant has obviated this rejection by preemptively filing a declaration under 37 C.F.R. § 1.132 stating Lewis A. Chodosh and Heather P. Gardner are the only co-inventors of the claimed invention, as none of other co-authors of this reference made independent contributions to the claimed invention. Because Gardner et al. no longer regarded as prior art under § 102(a), the rejection of claims of claims 44 and 46 under § 103(a) over this reference has also been rendered moot.

All other grounds of objection and rejection have been rendered moot by the amendment filed May 12, 2005 or by the attached examiner's amendment, and have therefore been withdrawn.

4. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

5. Claims 4, 39, 40, 42, 44, and 48 have been allowed and renumbered as claims 1-6, respectively.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (571) 272-0836. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, Ph.D. can be reached on (571) 272-0832. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stephen L. Rawlings, Ph.D.
Examiner
Art Unit 1643

slr
October 25, 2005